IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Timothy A. McDonough et al.		Atty. Docket No.:	003797.00007
Serial No.:	09/699,517	Group Art Unit:	2629
Filed:	October 31, 2000	Examiner:	Abbas Abdulselam
For:	User Notification System with an Illuminated Computer User Interface	Confirmation No.:	7863

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is an Appeal Brief in accordance with 37 C.F.R. § 41.37 in support of Appellants' October 13, 2006, Notice of Appeal and Pre-Appeal Brief Request for Review. Appeal is taken from the Final Office Action mailed June 13, 2006 (hereinafter referred to as, *Final Action*), and the Notice of Panel Decision from Pre-Appeal Brief Review mailed November 3, 2006. Please charge any necessary fees in connection with this Appeal Brief to our Deposit Account No. 19-0733.

I. REAL PARTY IN INTEREST

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is Microsoft Corporation.

II. RELATED APPEALS AND INTERFERENCES

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals and interferences.

III. STATUS OF CLAIMS

37 C.F.R. § 41.37(c)(1)(iii)

Claims 17-18, 33, 35, 37, and 39-52 remain pending. All are rejected. All rejections are appealed.

IV. STATUS OF AMENDMENTS

37 C.F.R. § 41.37(c)(1)(iv)

No amendment to the claims has been filed subsequent to the *Final Action*.

V. SUMMARY OF CLAIMED SUBJECT MATTER

37 C.F.R. § 41.37(c)(1)(v)

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention, Appellants do not intend to limit the claims; all references to the specification and drawings are illustrative unless otherwise explicitly stated.

The invention relates generally to apparatuses and methods for controlling an illumination member on a computer input device. More specifically, the invention relates to a notification method and system for controlling an illumination member on a computer input device based on an event, state or occurrence in a computer application. *Specification*, p. 1, ll. 9-13.

In accordance with at least one aspect of the present invention and as shown in Figure 6 or Appellant's original drawings, a computer processing unit 310 may be coupled to a computer input device control program 330 to control the "state" or "states" of one ore more illumination members 14 of a computer input device 10. *Specification*, p. 12, ll. 15-17. Such states may include: (1) whether the illumination member 14 of the computer input device 10 is ON or OFF; (2) the degree of illumination (the light intensity or amount of lumens) of the illumination member 14; (3) the color of the illumination member 14 (if the illumination member 14 is a

multicolor LED or other device permitting changes in color; and/or (4) the blinking or flashing of the illumination member 14 (and blinking or flashing sequences). *Specification*, p. 12, ll. 17-22. Such states may be affected by program routines 332, 334, 336, and 338. If more than one illumination member 14 is used on a computer input device 10, the state or states may be changed separately or simultaneously. If desired, a user may be given the option of overriding the changing of the states. *Specification*, p. 12, ll. 22-28.

States for the illumination member 14 may be controlled by a computer 200 in response to an event or occurrence, a condition, or any other activity relating to an application 320-322 being run by the computer 300. *Specification*, p. 12, ll. 29-31. This arrangement enables an occurrence, a state, or any other activity relating to any program 320-322 being run by the computer 300 to cause the illumination member 14 to change states. *Specification*, p. 13, ll. 8-10.

The illumination member 14 may change states in response to the receipt of an e-mail, voice mail, or facsimile message. *Specification*, p. 13, ll. 14-16. A comparison may be performed to see if the sender of the message is a predetermined user or a user from a predetermined list. Illumination member 14 may change states if the message was sent form a particular user or a user in a particular group. *Specification*, p. 13, ll. 17-20.

Many other programs that interact between multiple users include a solicitation feature. Such programs include communication software or chat rooms, instant messaging, and video and/or audio conference calls. An illumination member 14 on a computer input device 10 may change one or more states in response to receipt of a solicitation to join a chat room, instant messaging, or a call. Additionally or alternatively, illumination member 14 may change one or more states due to notification that a user has entered a common program or system and is now

capable of receiving a solicitation to join a chat room or call. *Specification*, p. 13, l. 29 to p. 14, l. 5.

An illumination member 14 of a computer input device 10 may change states in response to calendar and/or scheduling programs. *Specification*, p. 14, ll. 6-7. The relationship between the changing of one or more states and an item on the calendar or scheduling program may be set o be either instantaneous to the time or date or may be set to provide and advance warning of the set time and date. *Specification*, p. 14, ll. 8-15.

If an application program is an educational, trivia, or child development related game, an illumination member 14 may be an encouragement tool to change states in response to the entry of a correct answer. *Specification*, p. 14, ll. 19-22. If the application program is an adventure game, the illumination member 14 may change states when a character enters a dangerous area or situation, may change states when a player has run out of or is running out of a particular supply (e.g., food, money, or ammunition), may change states in response to being in a given proximity with a desirable or undesirable object, and/or may blink or flash with the number of blinks or flashes corresponding to the number of lives remaining. *Specification*, p. 14, ll. 22-28.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

37 C.F.R. § 41.37(c)(1)(vi)

The ground(s) of rejection to be reviewed on appeal include(s):

- Claims 39 and 51-52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Kreisel* reference (U.S. Patent No. 6,088,516).
- Claims 35 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference in view of the *Stanek* reference (U.S. Pat. No. 5,936,554).

- Claims 33, 37, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference.
- Claims 41 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference in view of the *Pennell* reference (U.S. Pat. No. 6,874,023).
- Claims 42 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference in view of the *Macko* reference (U.S. Pat. No. 6,052,563).
- Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference in view of the *Suzuki* reference (U.S. Pat. No. 5,890,139).
- Claims 44-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the *Kreisel* reference in view of the *Gough* reference (U.S. Pat. No. 6,360,221).

VII. ARGUMENT

37 C.F.R. § 41.37(c)(1)(vii)

Arguments Presented in Pre-Appeal Request for Review

During the Pre-Appeal process, Appellants noted the following errors, which Appellants believe represent the clearest reasons why the rejections should be overturned and the claims allowed. The specific errors relied upon in the Pre-Appeal Brief Request for Review include the following:

- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference (U.S. Patent No. 6,088,516) with respect to claims 33, 37, 39, 40, and 52 as argued in Appellant's amendment dated March 30, 2006, at pp. 8-9, 10-11, and 17.
- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference in view of the *Stanek* reference (U.S. Pat. No. 5,936,554) with respect to claims 35 and 49, as argued in Appellant's amendment dated March 30, 2006, at pp. 9-10.
- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference in view of the *Pennell* reference (U.S. Pat. No. 6,874,023) with

respect to claims 41 and 50, as argued in Appellant's amendment dated March 30, 2006, at pp. 11-13.

- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference in view of the *Macko* reference (U.S. Pat. No. 6,052,563) with respect to claims 17-18 and 42, as argued in Appellant's amendment dated March 30, 2006, at pp. 13-15.
- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference in view of the *Suzuki* reference (U.S. Pat. No. 5,890,139) with respect to claim 43, as argued in Appellant's amendment dated March 30, 2006, at p. 15.
- The Office exhibited clear error in its mistaken analysis and application of the *Kreisel* reference in view of the *Gough* reference (U.S. Pat. No. 6,360,221) with respect to claims 44-48, as argued in Appellant's amendment dated March 30, 2006, at pp. 16-17.

Notwithstanding, Appellants provide the following substantive arguments in support of this appeal, which incorporate the arguments cited above, and also presents additional issues that merit review.

Claim 39 stands rejected under 35 U.S.C. § 102(e) as being anticipated by Kreisel (U.S. Patent No. 6,088,516, hereinafter referred to as *Kreisel*).

Appellants' claim 39 recites, among other features, "wherein said determining step includes determining whether an instant message or an email message has been received, wherein said changing step includes changing the state associated with the illumination member in response to determining an instant message has been received." The Action fails to cite any reference that teaches or suggests at least these features of Appellants' claim 39.

The *Kreisel* system describes an E-mail system in which authorized users are afforded the ability to create multiple network sites and in which a visual indicator is provided upon the keyboard to identify new messages. (Abstract). The *Final Action* relies on reference element 204 in Figure 2 and column 8, lines 61-66 of *Kreisel* as describing determining whether an instant

message has been received. Neither the cited portion of *Kreisel* nor any other portion of *Kreisel* teaches or suggests at least this feature. The cited portion reads,

> FIG. 2 illustrates the processing sequence (hereafter the "LED control function") performed at set intervals when called by the New Mail Interrupt. When called (step 200), the LED control function reads a global or system variable or flag identifying incoming mail (step 202) and evaluates the state of the Flag (true or false) (step 204). (Col. 8, ll. 61-6).

At best, *Kreisel* describes an email system. *Kreisel* fails to teach or suggest anything with respect to instant messaging technology and further fails to teach or suggest any type of difference between receipt of an incoming email and an incoming instant message. Accordingly, claim 39 is allowable over *Kreisel* and withdrawal of the rejection is respectfully requested. Appellants' dependent claim 51 depends from claim 39 and is at least allowable over the art of record for the same reasons as its ultimate base claim and further in view of the novel features recited therein.

Appellants' claim 52 recites, among other features, "communicating with the computer input device having the illumination member to cause the illumination member to change to a third state in response to determining that the predetermined event corresponds to input of a correct answer." In rejecting this feature of claim 52, the *Final Action* merely states, "Kreisel teaches that the Scroll Lock LED may be controlled to flash at a given rate regardless of the number of new messages (col. 9, lines 10-21)." (*Final Action*, p. 19). Appellants respectfully traverse this rejection. The cited portion, column 9, lines 10-21, of *Kreisel* fails to describe anything related to the claim language of claim 52. The ability to control a Scroll lock LED to flash at a given rate regardless of the number of new messages is irrelevant. Neither the cited portion nor any other portion of *Kreisel* teaches or suggest "communicating with the computer input device having the illumination member to cause the illumination member to change to a third state in response to determining that the predetermined event corresponds to input of a correct answer." Accordingly, claim 52 is allowable over *Kreisel* and withdrawal of the rejection is respectfully requested.

Claims 35 and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Stanek (U.S. Patent No. 5,936,554, hereinafter referred to as *Stanek*).

As admitted by the *Final Action*, "Kreisel does not specifically teach establishing a set of senders and determining whether a sender of an incoming message is in the set (*Final Action*, p. 7). To cure these deficiencies, the *Final Action* alleges,

> On the other hand, Kreisel teaches a communications package 3 [that] includes memory containing an incoming queue 23 and an outgoing queue 25 to store messages and/or data files (col. 3, lines 14-26). Kreisel also teaches as shown in Fig. 4 a processing sequence including a status of newly received messages (Fig. 4(204)).

However, neither this statement nor the cited portion teaches or suggests anything with respect to, "establishing a set of senders, wherein said determining step includes determining whether a sender of an incoming message is in the set," as recited in Appellants' claims 35 and 49. The statement in the *Final Action* and the cited portions of *Kreisel* at best describe storage and analysis of incoming emails where the state of a Flag, identifying reception of a new email, is evaluated. Neither *Kreisel* nor *Stanek* teaches or suggests anything with respect to the sender of an incoming message. Appellants do no disagree that *Kreisel* describes evaluation of state of a Flag identifying reception of a new email; however, this does not amount to the features of Appellants' claims 35 and 49. As such, for at least these reasons, Appellants respectfully request withdrawal of the present rejection of claims 35 and 49.

Claims 33, 37, and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel*.

Appellants' claim 37 recites, among other features, "establishing a set of senders, wherein said determining step includes determining whether a sender of an incoming message is in the set." As admitted by the *Final Action*, *Kreisel* fails to specifically teach these features. (*Final Action*, p. 5). In response, the *Final Action* provides the same statement and citations of *Kreisel* as described above with reference to Appellants' claims 35 and 49. For similar reasons as described above with reference to Appellants' claims 35 and 49, *Kreisel* describes evaluation of state of a Flag identifying reception of a new email; however, this does not amount to the features of Appellants' claim 37. As such, for at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 37. Claim 33, which depends on claim 37, is patentably distinct over the art of record for at least the same reasons as its ultimate base claim and further in view of the novel features recited therein.

Appellants' claim 40 recites, among other features, "wherein said determining step includes determining whether a request to respond to one of a video conference call and an audio conference call has been received." As admitted by the *Final Action*, *Kreisel* fails to specifically teach this feature (*Final Action*, p. 11). In response, the *Final Action* alleges,

> Kreisel on the other hand teaches as shown in Fig. 1a a plurality of computer terminals 2 remotely located from one another, with each of the terminals having an electronic communications package 3 or 5 installed (col. 2, lines 60-62).
>
> It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communicating and interacting with one another (col. 2, lines 36-38).

However, neither this statement nor the cited portions of *Kreisel* teaches or suggests anything with respect to, "wherein said determining step includes determining whether a request to respond to one of a video conference call and an audio conference call has been received," as recited in Appellants' claim 40. The statement in the *Final Action* and the cited portions of *Kreisel* at best describe a system where various computers have a common application program running and the communications are email communications. Neither *Kreisel* nor *Stanek* teaches or suggests anything with respect to receipt of a request to respond to a video conference call or an audio conference call. Appellants do no disagree that *Kreisel* describes transmission and identification of receipt of a new email; however, this does not amount to the features of Appellants' claim 40. As such, for at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 40.

Claims 41 and 50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Pennell et al. (U.S. Patent No. 6,874,023, hereinafter referred to as *Pennell*).

Appellants' independent claim 41 recites, among other features, "wherein said determining step includes determining whether a user is capable of receiving a solicitation." As admitted by the *Final Action*, *Kreisel* fails to teach or suggest this feature. (*Final Action*, p. 11). To cure these deficiencies, the *Final Action* relies on Figure 4 and column 1, lines 42-45 of *Pennell* and states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt

Pennell's user control with respect to emails as indicated in Fig. 4 because user control over emails helps increase convenience in managing a user's Internet communications as taught by Pennell." (*Final Action*, p. 12). However, the combination of references fails to teach or suggest Appellants' claim 41 feature of, "wherein said determining step includes determining whether a user is capable of receiving a solicitation." Even under the *Pennell* system, a user is only notified, on a display screen, of new email messages, and there is nothing in *Pennell* to teach or suggest whether a user is capable of receiving a solicitation. As such, for at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 41.

Even assuming, without admitting, that the combination of *Kreisel* and *Pennell* teaches or suggests each and every feature of Appellants' claim 41, the motivation to combine *Kreisel* and *Pennell* is improper. *Kreisel* is directed to flashing of particular LEDs on a keyboard upon receipt of a new email. *Pennell*, on the other hand, is a web based application in which a user has an account and visual notification on a display screen may be provided regarding a number of criteria, such as a new email message. There is no motivation provided in either of *Kreisel* or *Pennell* to combine the hardware applications of *Kreisel* with the software based Internet communication controls of *Pennell*. As such, there is no motivation shown to combine *Kreisel* with *Pennell*.

Appellants' independent claim 50 recites, among other features, "wherein said determining step includes determining whether a request to respond to a solicitation to join a chat room has been received." As admitted by the *Final Action*, *Kreisel* fails to teach or suggest this feature. (*Final Action*, p. 12). To cure these deficiencies, the *Final Action* relies on the same portions of *Pennell* as described above with respect to Appellants' claim 41 and further states that, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize Kreisel's network of multiple terminals (2) shown in Fig. 1a for the purpose of communication and interacting with one another." (*Final Action*, p. 13). However, the *Final Action* appears to contend that mere capability to transmit email messages between computers constitutes the capability to chat within a chat room. The differences in capabilities between the two are numerous and such a contention, if being made, is not supported by the references themselves. As such, for at least these reasons, Appellants respectfully request withdrawal of the

present rejection of claim 50. In addition, for at least the same reasons as provided above with respect to Appellants' claim 41, the motivation to combine *Kreisel* with *Pennell* is improper.

Claims 42 and 17-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Macko (U.S. Patent No. 6,052,563, hereinafter referred to as *Macko*).

Appellants' independent claim 42 recites, among other features, "wherein said determining step includes comparing a scheduled event time relative to an actual time set in the computer." As admitted by the *Final Action*, *Kreisel* fails to teach or suggest this feature. (*Final Action*, p. 14). To cure these deficiencies, the *Final Action* relies on *Macko*.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim features. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *Kreisel* with *Macko*. As reason for combing the references with respect to Appellants' claim 42, the *Final Action* states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Macko's email forwarding program (700) as configured in FIG. 13 because an email forwarding program helps automatically forward emails to a communication device (100) as taught by Macko." (*Final Action*, p. 14). However, the alleged reason does not provide motivation to combine the references, but rather is nothing more than the conclusion apparently reached after having benefited from reading Appellants' own disclosure, and thus constitutes impermissible hindsight. The *Final Action* alleges that the motivation to combine the references can be found in Figure 13 and column 8, lines 1-4 and 56-67 of *Macko*. This cited portion of *Macko* reads,

> If any other messages are received during this appointment, the communication device will send a response message indicating that he/she is in a meeting…
> The electronic mail (email) forwarding application is selected for activation when a travel appointment, or any other particular appointment, is entered. Referring to FIG. 13 in conjunction with FIGS. 1 and 3, the email forwarding application will be described. When active, in step 700 a flag is set to activate a companion program in the PC to forward email for the duration of the scheduled

> appointment. In step 702, the appointment and associated configuration information in the communication device 100 is synchronized with that of the companion program in the PC 130 (normally at least once a day).

However, the communication device of *Macko* correlates to a cellular telephone (col. 1, lines 6-10) and neither *Macko* nor *Kreisel* teaches or suggests use of features in a cellular telephone in a computer input device. Even assuming without admitting that the combination of *Macko* and *Kreisel* teaches or suggests each and every feature of Appellants' claim 42, the above description of Figure 13 of *Macko* would teach away from such a need. Email would not need to be forwarded to a communication device if we are referring to a computer input device. Changing a state of an illumination member of a computer input device connected to PC 130 of *Macko* would be useless as any emails are merely forwarded to a user's cellular telephone.

The Federal Circuit has repeatedly stated that the elements of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). Thus, Appellants respectfully submit that that there is no motivation or suggestion to combine *Kreisel* with *Macko*.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the *Final Action* provides no evidence that the combination takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made. Nor does the *Final Action* provide any evidence that the combination includes knowledge gleaned from any source other than Appellants' disclosure. As such, utilizing the teachings of Appellants' written description and drawings, the *Final Action* merely cites *Macko* in an attempt to piece the rejection together. Therefore, the combination is an improper combination based on hindsight. For at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 42.

Appellants' claims 17-18, which depend from claim 42, are patentably distinct over the art of record for at least the same reason as their ultimate base claim and further in view of the novel features recited therein.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Suzuki et al. (U.S. Patent No. 5,890,139, hereinafter referred to as *Suzuki*).

Appellants' independent claim 43 recites, among other features, "wherein said determining step includes determining whether a correct answer has been input." As admitted by the *Final Action*, *Kreisel* fails to teach or suggest this feature. (*Final Action*, p. 15). To cure these deficiencies, the *Final Action* relies on *Suzuki*. Specifically, the *Final Action* relies on element S109 of Figure 5 and column 7, lines 8-14 of *Suzuki* and states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Suzuki's answer transmission via email (109) as configured in Fig. 5 because the use of answer transmission via email helps function online shopping as taught by Suzuki." (*Final Action*, p. 11). However, the combination of references fails to teach or suggest Appellants' claim 43 feature of, "wherein said determining step includes determining whether a correct answer has been input." Even under the *Suzuki* system, an answer to a customer's question is always transmitted to the user and neither system, whether *Kreisel* of *Suzuki*, teaches or suggest determining whether the transmitted answer is a correct answer. *Suzuki* teaches or suggests nothing with respect to determining the accuracy of an answer that the mail order center 100 provides. As such, for at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 42.

Even assuming, without admitting, that the combination of *Kreisel* and *Suzuki* teaches or suggests each and every feature of Appellants' claim 42, the motivation to combine *Kreisel* and *Suzuki* is improper. *Kreisel* is directed to flashing of particular LEDs on a keyboard upon receipt of a new email. *Suzuki*, on the other hand, is a web based question and answer system in which answers are provided to a customer from minimum necessary answers to questions prepared in a database. There is no motivation provided in either of *Kreisel* or *Suzuki* to combine the two references.

Claims 44-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kreisel* in view of Gough et al. (U.S. Patent No. 6,360,221, hereinafter referred to as *Gough*).

Appellants' independent claim 44 recites, among other features, "wherein said determining step includes determining one of a state, a characteristic, and a condition relating to a character in a game program." As admitted by the *Final Action*, *Kreisel* fails to teach or suggest this feature. (*Final Action*, p. 16). To cure these deficiencies, the *Final Action* relies on *Gough*.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim features. *See* MPEP § 706.02 (j); *In re Vaeck* , 947 F.2d 488 (Fed. Cir. 1991).

However, there is no motivation or suggestion to combine *Kreisel* with *Gough*. As reason for combing the references with respect to Appellants' claim 44, the *Final Action* states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kreisel's email communication shown in Fig. 1b to adapt Gough's enhanced interactive email driven game as demonstrated in Fig. 13 because the use of enhanced interactive email helps attract users and members to the websites as taught by Gough." (*Final Action*, p. 16). However, the alleged reason does not provide motivation to combine the references, but rather is nothing more than the conclusion apparently reached after having benefited from reading Appellants' own disclosure, and thus constitutes impermissible hindsight. The *Final Action* alleges that the motivation to combine the references can be found in Figure 13 and column 15, line 66 to column 16, line 13 and column 2, lines 45-49 of *Gough*. This cited portion of *Gough* describes how two individuals can email one another back and forth making new moves in a chess game. The cited portion states that the email includes an interactive game of chess, but fails to teach or suggest in any manner as to how the email could possibly interact with a computer input device of a user. There is no motivation in *Gough* or *Kreisel* to change a state associated with the illumination member on a computer input device in response to determining one of a state, a characteristic, and a condition relating to a character in a game program.

The Federal Circuit has repeatedly stated that the elements of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re*

Dembiczak, and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). That is exactly what is occurring here as the *Final Action* specifies nothing for motivation to combine the two references. Thus, Appellants respectfully submit that that there is no motivation or suggestion to combine *Kreisel* with *Gough*.

Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the *Final Action* provides no evidence that the combination takes into account only knowledge which was within the level of one of ordinary skill at the time the claimed invention was made. Nor does the *Final Action* provide any evidence that the combination includes knowledge gleaned from any source other than Appellants' disclosure. As such, utilizing the teachings of Appellants' written description and drawings, the *Final Action* merely cites *Gough* in an attempt to piece the rejection together. Therefore, the combination is an improper combination based on hindsight.

In addition, even assuming, without admitting, that the combination of *Kreisel* and *Gough* is proper, the combination still fails to teach or suggest each and every feature of Applicants' claim 44. For example, claim 44 recites "one of a state, a characteristic, and a condition ***of a character*** in a game program" (emphasis added). However, *Gough* merely describes how a chess board may be emailed back and forth between two people with each email being a corresponding move by the other person. (*Gough*, col. 15, l. 66 to col. 16, l. 14). Yet, such is not "of a character in a game program" as recited in claim 44. The game program is a chess program and there are no underlying characters participating in the chess program as described by *Gough*. For at least these reasons, Appellants respectfully request withdrawal of the present rejection of claim 44.

Appellants' claims 45-48, which depend from claim 44, are patentably distinct over the art of record for at least the same reason as their ultimate base claim and further in view of the novel features recited therein. For example, Appellants' claim 45 recites, among other features, "determining whether the character is within a given proximity of an object." The *Final Action* cites Figure 13 and col. 15, l. 66 to col. 16, l. 14 of *Gough* as describing this feature. However, there is nothing within Gough to suggest a determining as to whether a character is within a given proximity of an object. Gough describes nothing more than a chess program that emails

the end product of respective moves back and forth. The *Final Action* fails to describe what the "object" is in *Gough* and how a character is determined to be "within a given proximity" of that object. Appellants' claim 46 recites, among other features, "a number of lives remaining for the character," claim 47 recites, among other features, "an amount of a supply for the character," and claim 48 recites, among other features, "the character entering an area in the game program." With respect to each of these features, the *Final Action* cites the same portion of *Gough* describing a chess program being emailed back and forth and merely sates that it would have been obvious to reprogram *Gough* for additional functionalities (*Final Action*, p. 17). As such, the *Final Action* admits that *Gough* fails to explicitly teach each and every feature and merely relies on an inherency or well known in the art response. Appellants respectfully traverse any such contention and stand by the fact that none of the references of record teach or suggest any of these features of Appellants claims 45-48. With respect to the allegation that it would have been obvious to reprogram *Gough*'s chess game for additional functionalities, Appellants request a reference describing such and a motivation to allegedly combine these references including with respect to a chess game as described by *Gough*.

CONCLUSION

For all of the foregoing reasons, Appellants respectfully submit that the final rejection of the claims referenced in section VI, above, is/are improper and should be reversed.

Respectfully submitted,
BANNER & WITCOFF, LTD.

By: /John M. Fleming/
John M. Fleming
Registration No. 56,536

1001 G Street, N.W.
Eleventh Floor
Washington, D.C. 20001-4597
(202) 824 3000
Dated: December 20, 2006

CLAIMS APPENDIX

37 C.F.R. § 41.37(c)(1)(viii)

Claim 17: The method of claim 42, wherein said determining step includes determining whether the actual time set in the computer is the same as the scheduled event time.

Claim 18: The method of claim 42, wherein said determining step includes determining whether the actual time set in the computer has reached a time prior to the scheduled event time.

Claim 33: The method of claim 37, wherein the computer input device is a track-mouse device.

Claim 35: A computer-readable medium having computer-executable instructions for performing steps comprising:

(a) determining, in a computer, whether a predetermined event has occurred;

(b) communicating with a computer input device having an illumination member to cause the illumination member to change states in response to the determining step; and

(c) establishing a set of senders,

wherein said determining step includes determining whether a sender of an incoming message is in the set,

wherein said communicating step includes causing the illumination member to change intensity.

Claim 37: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred;

(b) changing a state associated with the illumination member in response to the determination step; and

(c) establishing a set of senders,

wherein said determining step includes determining whether a sender of an incoming message is in the set.

Claim 39: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether an instant message has been received and determining whether an email message has been received,

wherein said changing step includes changing the state associated with the illumination member to a first state in response to determining an instant message has been received and changing the state associated with the illumination member to a second state in response to determining an email message has been received.

Claim 40: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether a request to respond to one of a video conference call and an audio conference call has been received.

Claim 41: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether a user is capable of receiving a solicitation.

Claim 42: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes comparing a scheduled event time relative to an actual time set in the computer.

Claim 43: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether a correct answer has been input.

Claim 44: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining one of a state, a characteristic, and a condition relating to a character in a game program.

Claim 45: The method of claim 44, wherein said determining step includes determining whether the character is within a given proximity of an object.

Claim 46: The method of claim 44, wherein said changing step includes causing the illumination member to change states in a manner corresponding to a number of lives remaining for the character.

Claim 47: The method of claim 44, wherein said changing step includes causing the illumination member to change states in a manner corresponding to an amount of a supply for the character.

Claim 48: The method of claim 44, wherein said changing step includes causing the illumination member to change states in a manner corresponding to the character entering an area in the game program.

Claim 49: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred;

(b) changing a state associated with the illumination member in response to the determination step; and

(c) establishing a set of senders,

wherein said determining step includes determining whether a sender of an incoming message is in the set,

wherein said changing step includes causing the illumination member to change intensity.

Claim 50: A method for controlling an illumination member on a computer input device, said method comprising:

(a) determining, in a computer, whether a predetermined event has occurred; and

(b) changing a state associated with the illumination member in response to the determination step,

wherein said determining step includes determining whether a request to respond to a solicitation to join a chat room has been received.

Claim 51: The method of claim 39, wherein the first state and the second state are different states.

Claim 52: A computer-readable medium having computer-executable instructions for performing steps comprising:

(a) determining, in a computer, whether a predetermined event has occurred;

(b) communicating with a computer input device having an illumination member to cause the illumination member to change to a first state in response to determining that the predetermined event corresponds to receipt of a new email message;

(c) communicating with the computer input device having the illumination member to cause the illumination member to change to a second state in response to determining that the predetermined event corresponds to receipt of a new instant message; and

(d) communicating with the computer input device having the illumination member to cause the illumination member to change to a third state in response to determining that the predetermined event corresponds to input of a correct answer.

EVIDENCE APPENDIX

37 C.F.R. § 41.37(c)(1)(ix)

None.

RELATED PROCEEDINGS APPENDIX

37 C.F.R. § 41.37(c)(1)(x)

None.